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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/444,711 11/24/99 YEATMAN T 114205.400

021269
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HM12/0926

EXAMINER

HARRIS, A

ART UNIT

PAPER NUMBER

1642

4

DATE MAILED:

09/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/444,711

Applicant(s)

Yeatman And Irby

Examiner
Alana M. Harris, Ph. D.

Group Art Unit
1642



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-28 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-28 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1642

Election/Restriction

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 3, 4, 9-11, 19 and 21-27, drawn to a recombinant, classified in class 536, subclass 23.1.
 - II. Claims 21 and 28, drawn to a polypeptide, classified in class 530, subclass 350.
 - III. Claim 5, drawn to a method of screening comprising administering of one or more test compound, classified in class 435, subclass 4.
 - IV. Claims 6 and 7, drawn to a method of treating a cancer administering compound capable of inhibiting excess kinase activity, classified in class 435, subclass 6.
 - V. Claim 8, drawn to a preparation comprising antibodies, classified in class 424, subclass 130.1.
 - VI. Claims 12 and 13, drawn to a primer and a diagnostic kit comprising said primers, classified in class 536, subclass 24.33.
 - VII. Claim 14, drawn to a nucleic acid probe, classified in class 536, subclass 24.31.
 - VIII. Claim 15, drawn to a method for detecting SRC531 mutation comprising contacting a nucleic acid, classified in class 435, subclass 7.6.
 - IX. Claim 16, drawn to a cancer vaccine, classified in class 424, subclass 184.1.
 - X. Claim 17, drawn to a method for detecting the presence of SRC531 mutation comprising contacting a sample with primers, classified in class 435, subclass 91.2.

Art Unit:

XI. Claim 18, drawn to a cell line, classified in class 435, subclass 325.

XII. Claim 20, drawn to a transgenic mouse, classified in class 800, subclass 18.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I, II, V-VII, IX, XI and XII are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups III, IV, VIII and X differ in the method objectives, method steps and parameters and in the reagents used.

Inventions of Group I , II, V or IX and of Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case each product of Group I, II, V or IX can be used in the method of Group III.

Inventions of Group I , II, V or IX and of Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that

Art Unit:

product (MEP. § 806.05(h)). In the instant case each product of Group I, II, V or IX can be used in the method of Group IV.

Inventions of Group I and of Group VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the recombinant nucleic acid of Group I can be used in *in vivo* therapy methods.

Inventions of Group VI and of Group X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the primer of Group VI can be used in sequencing methods.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit:

4. Attempts to reach Gilberto M. Villacorta by telephone on September 25, 2000 to request an oral election to the above restriction requirement were unsuccessful.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).


6. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Anthony Caputa, Ph.D., Supervisory Patent Examiner at Anthony.Caputa@uspto.gov or 703-308-3995. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

7. Papers related to this application may be submitted to Group 1642 by facsimile transmission. Papers should be faxed to Group 1642 via the PTO Fax Center located in Crystal

Art Unit:

Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Crystal Mall One Fax Center telephone number is (703) 308-4242 or (703) 305-3014.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris whose telephone number is (703)306-5880. The examiner can normally be reached on Monday through Friday from 6:30 am to 3:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703)308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0196.


GEETHA P. BANSAL
PRIMARY EXAMINER